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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,406	01/23/2002	Gilles Jourdin	VAL1599P0251US	1614

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CITICORP CENTER, SUITE 3800
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CHICAGO, IL 60661-2511

EXAMINER

SMALLEY, JAMES N

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,406

Applicant(s)

JOURDIN, GILLES

Examiner

James N. Smalley

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 and 16 is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 10, 12-15, 17, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 18, 19 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Due to the new grounds of rejection, this Action is hereby made **Non-Final**.

Allowable Subject Matter

2. The indicated allowability of claims 17 and 20-21 are withdrawn in view of the newly discovered reference(s) to Kogyosho JP 9-110084 and Von Shuckmann US 4,732,549. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 7, 10, 12-14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Shuckmann US 4,732,549.

Shuckmann '549 teaches a container with a pump tube (B) secured in the neck opening by a retainer ring having ribs (39) extending the height of the skirt, and an overcap (9) secured over the ring. The cap is read to be definitively secured on the neck, because it would not fall off of the container unless it was pried off with substantial force.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-3, 7, 10, 12-15, 17 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kogyosho JP 9-110084.

Kogyosho '084 teaches a container to secure a pump in the neck opening by a retainer ring (2) with ribs (9) extending the height of the skirt, and an overcap (10) secured over the ring. Being formed of plastic, the ring inherently deforms radially inwardly at the location of the ribs.

It is not clear if the ribs on the ring extend the height of the skirt. Examiner notes that while they clearly terminate short of the horizontal ledge, the ledge and skirt are connected by a rounded edge which makes the definitive boundary of the skirt unclear. However, the overcap inner surface contains ribs (12) to engage ribs (9) on the ring, which clearly extend the height of the skirt.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the ring and overcap of Kogyosho '084, reversing the location of the ribs on each element with the other's ribs, because it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

Alternatively, Examiner notes the changing of the size of the ribs of Kogyosho '084, extending them to the full height of the skirt, is obvious without evidence of an unexpected result. In the instant case, there does not appear to be an unexpected result derived from extending the length of the ribs on the ring to the full height of the skirt. One having ordinary skill would be motivated to do this in order to provide a more secure connection between the overcap and the ring. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would

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have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-3, 7, 10, 12-15, 17 and 20-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,571,991 in view of Kogyosho JP 9-110084 and in view of Kurihara et al. US 3,863,798.

The '991 fails to teach longitudinal ribs extending the height of the skirt to secure an overcap.

Kogyosho '084 teaches a container with a pump secured in the neck opening by a retainer ring (2) with ribs (9) extending the height of the skirt, and an overcap (10) secured over the ring. Being formed of plastic, the ring inherently deforms radially inwardly at the location of the ribs.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the ribs of Kogyosho '084 on the external surface of the ring of the '991 patent in order to engage the collar to provide a secure connection between the two elements.

9. Claims 1-3, 7, 10, 12-15, 17 and 20-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,575,339 in view of Kogyosho JP 9-110084 and in view of Kurihara et al. US 3,863,798.

The '339 fails to teach longitudinal ribs extending the height of the skirt to secure an overcap.

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Kogyosho '084 teaches a container with a pump secured in the neck opening by a retainer ring (2) with ribs (9) extending the height of the skirt, and an overcap (10) secured over the ring. Being formed of plastic, the ring inherently deforms radially inwardly at the location of the ribs.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the ribs of Kogyosho '084 on the external surface of the ring of the '339 patent in order to engage the collar to provide a secure connection between the two elements.

10. Claims 1-3, 7, 10, 12-15, 17 and 20-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,595,395 in view of Kogyosho JP 9-110084 and in view of Kurihara et al. US 3,863,798.

The '395 fails to teach longitudinal ribs extending the height of the skirt to secure an overcap.

Kogyosho '084 teaches a container with a pump secured in the neck opening by a retainer ring (2) with ribs (9) extending the height of the skirt, and an overcap (10) secured over the ring. Being formed of plastic, the ring inherently deforms radially inwardly at the location of the ribs.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the ribs of Kogyosho '084 on the external surface of the ring of the '395 patent in order to engage the collar to provide a secure connection between the two elements.

Allowable Subject Matter

11. Claims 4-6 and 16 are allowed.

12. Claims 18-19 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N. Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on M-Th 9-6:30, Alternate Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jns


NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER